

REMARKS

In view of the preceding amendments and the comments which follow, and pursuant to 37 CFR §1.111, amendment and reconsideration of the Official Action of September 10, 2003 is respectfully requested by Applicants.

A Claims Listing dated February 9, 2004 has been submitted herewith.

Claims 16 and 19-23 have been amended; claims 17 and 18 have been cancelled. Support for the amended language is found throughout the originally filed specification; no new matter has been added.

Rejections under 35 USC §112, second paragraph

Claims 6-7, 16-20, and 22 have been rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The Examiner has rejected claims 6-7 for reciting the sequence “according to” SEQ ID NO: 5 and argues that use of the term “according to” is indefinite as it is unclear if the meaning of the term is open, i.e., comprising, or closed, i.e., consisting of.

In response, Applicants have amended claims 6 and 7 appropriately, thereby avoiding the rejection.

The Examiner has rejected claim 16 for reciting the limitation “the alkaline phosphatase gene” and argues that there is insufficient antecedent basis for this limitation.

In response, Applicants have amended claim 16 accordingly, thereby avoiding the rejection.

The Examiner has rejected claims 17-18 for reciting that the gene sequence “corresponde to” SEQ ID NO: 1 and argues that use of the term “corresponds to” is

indefinite as it fails to establish the metes and bounds of the gene sequences encompassed by the claimed language.

Claims 17 and 18 have been cancelled, and thus this grounds for rejection is moot.

The Examiner has rejected claims 16-23 for reciting that the medium contains selection marker and argues that the specification and the prior art define selection marker as a resistance or selection gene that encodes resistance to antibiotics or drugs added to the medium.

In response, Applicants have amended claims 16-23 to clarify that the first and second marker genes encode resistance to first and second antibiotics, respectively, thereby overcoming the rejection.

The Examiner has rejected claims 19-20 for reciting use of yeast cells while not reciting how this element is to be used. The Examiner also points out that the claims also recite “transformants are used” and a “second vector is used” while not reciting how they are used.

In response, Applicants have amended claims 19 and 20 appropriately, thereby overcoming the rejection.

The Examiner has rejected claim 22 for reciting the limitation “the alkaline phosphatase gene” and argues that there is insufficient antecedent basis for this limitation.

In response, Applicants have amended claim 22 accordingly, thereby avoiding the rejection.

The Examiner has further rejected claim 22 for reciting that the yeast cells are transformed “more than one time” with a vector and argues that, as recited, selection for transformants that have incorporated multiple copies is performed following the multiple

transformation steps. It is unclear how transformants that have incorporated multiple copies are differentiated from those that have incorporated single copies.

As now amended, claim 22 clarifies that transformants that have incorporated multiple copies of the marker gene are differentiated from those that have incorporated single copies by using a medium containing a higher concentration of antibiotic.

By way of the present amendments to claims 6-7, 16-20, and 22, the rejections under 35 USC 112, first paragraph, have been overcome or avoided, and Applicants respectfully request the Examiner's reconsideration of the rejection.

Rejections under 35 USC §112, first paragraph

Claims 16 and 19-23 have been rejected under 35 USC §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner argues that claims 16 and 19-23 read on a genus of eukaryotic alkaline phosphatase genes, but that Applicants have only disclosed an alkaline phosphatase encoded by SEQ ID NO: 1 and SEQ ID NO: 5. It is the Examiner's position that the disclosure of one species would not represent to the skilled artisan a representative number of species sufficient to show Applicants were in possession of the claimed genus.

As now amended, claims 16 and 22 are limited to alkaline phosphatase genes comprising a sequence selected from the group consisting of SEQ ID NO: 1 and SEQ ID NO: 5. The claims having been thus limited, the Examiner's grounds for rejection have been overcome, and reconsideration of the rejection is requested by Applicants.

Applicants submit that their application is now in condition for allowance, and favorable reconsideration of their application in light of the above amendments and

remarks is respectfully requested. Allowance of claims 6, 7, and 16-23 at an early date is earnestly solicited.

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The Examiner is hereby authorized to charge any fees associated with this Amendment to Deposit Account No. 02-2958. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

A handwritten signature in cursive script, reading "Marilyn L. Amick". The signature is written in dark ink and is positioned above a horizontal line.

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